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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,755	07/24/2001	J. Michael Milliorn	P02166US0	5349
26271	7590	05/03/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/912,755	Applicant(s) MILLIORN, J. MICHAEL	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-21, 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Applicant has not amended any claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11, 13-21 and 23-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (6,420,006) in view of applicant's admittance.

Scott discloses in Fig. 2-5, an adhesive label comprising: polypropylene material; a first section (16a), a second section (24) each having a first side (20) and a second side (18), wherein the first side of the first section is contiguous with the first side of the second section, and wherein the second section forms a non-adhesive tab portion (24) extending from an edge (b) of the first section; a releasable adhesive layer (28) covering the first side (20) of the first section and configured such that the degree of adhesion is uniform such that the entire label detaches from a substrate surface (10) when the tab is pulled upon. Scott also discloses wherein the second side of the first portion is adapted to be written upon (Col. 4, lines 23-26). Scott further discloses: wherein the second section tab portion extending from the first section, wherein the second section tab portion has an edge (b) interconnected with the edge of the first section; and a label liner (38) holding a plurality of labels (Fig. 8-14), and adapted to form a roll (Fig. 15).

However, Scott does not disclose: a label adapted to remained adhered to a substrate during exposure to various temperatures ranging between -40 degrees Celsius and 50 degrees Celsius and the entire label can be removed from the substrate after exposure to temperatures ranging from -40 degrees Celsius and 50 degree Celsius; and wherein the second side accepts

Art Unit: 3722

printing related to food safety labeling systems; and wherein the interconnected edges form a rounded edge.

Applicant has admitted in the Specification on page 4 to the use of an adhesive which is adapted to remain adhered at temperatures ranging from -40 degrees Celsius to 50 degrees Celsius, yet is easily removable at the same temperatures.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scott's label to include adhesive which can remain adhered at temperatures ranging at -40 degrees Celsius to 50 degrees Celsius as taught by Applicant's admittance for the purpose of providing adhesion to an item exposed to various degrees of temperatures.

In regards to **Claims 7-11 and 23-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable indicia on the second side of the label such as food related indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Mere support by the substrate (second side surface) for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability. Therefore, it would have been obvious to use any

Art Unit: 3722

desired text in applicant's invention, since applicant has not disclosed the criticality of a particular text and that invention would function for any text used for labeling stored items.

In regards to **Claims 9-11, 26-33** with respect to the ink color, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. Therefore, it would be obvious to one having ordinary skill in the art to modify the Scott reference with ink color of any desirable color, since the ink color would depend on the intended use of what the user wanted to display. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore the label of the Scott reference can have a graphical color that is related to an industry code used in food safety systems.

In regards to **Claims 15-17**, it would have been an obvious matter of design choice to make the first section, the second section, and different portions of the interconnected edges of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious to modify the Scott reference to include any surface area which can be lifted by a finger for the purpose of removing the label.

Art Unit: 3722

Response to Arguments

3. Applicant's arguments filed on September 30, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach or disclose an adhesive that is adapted to adhere at temperatures ranging from -40 degree Celsius to 50 degree Celsius, the examiner submits again that Applicant has indeed disclosed an admission of prior art (on page 4 of the specification, paragraph 0022, wherein applicant states that the adhesive "is commonly known in the art") to the use of an adhesive sold by AVERY DENNISON under the trade name FASSON R-10 which can be used to adhere a label to a surface substrate when subjected to particular temperature degrees. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scott's label with an adhesive which can remain adhered at temperatures ranging at -40 degrees Celsius to 50 degrees Celsius as taught by Applicant's admittance for the purpose of providing adhesion to an item exposed to various degrees of temperatures.

In regards to applicant's argument that there is nothing to suggest to combine the teachings of Scott with an adhesive which can retain its adhesive properties over a broad range of temperatures, the examiner submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

Art Unit: 3722

knowledge generally available to one of ordinary skill in the art. In this case, Scott reference is relied upon for disclosing a label which can be placed on packages, wherein the packages as with any package could be subjected to a broad range of storing temperatures (from freezer temperatures to room temperature) as desired by end user. However, Scott does not disclose a label adapted to remained adhered to a substrate during exposure to various temperatures ranging between -40 degrees Celsius and 50 degrees Celsius and the entire label can be removed from the substrate after exposure to temperatures ranging from -40 degrees Celsius and 50 degree Celsius. Applicant's admission is relied upon for disclosing thus use of an adhesive which can be used in place of the adhesive on the label in the Scott reference, wherein the use of an adhesive allows a label to remain adhered at temperatures ranging from -40 degrees Celsius to 50 degrees Celsius, yet is easily removable at the same temperatures.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scott's label with an adhesive which can remain adhered at temperatures ranging at -40 degrees Celsius to 50 degrees Celsius as taught by Applicant's admittance for the purpose of providing adhesion to an item exposed to various degrees of temperatures.

Therefore, the rejection has been maintained.

Art Unit: 3722

Conclusion

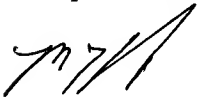
4. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 26, 2004



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